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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/653,301	09/02/2003	Randall Jay Briggs	100205079-1	2760

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EXAMINER

BUI, LUAN KIM

ART UNIT PAPER NUMBER

3728

DATE MAILED: 12/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/653,301

Applicant(s)	
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BRIGGS ET AL.

Examiner

Luan K. Bui

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 13-16, 22, 23, 26-29, 32, 33 and 36-40 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 13-16, 22, 23, 26-29, 32, 33 and 36-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 22, 32 and 36 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Loudenslager (5,828,545). Loudenslager discloses a CPU unit/portable electronic device (12) comprising a compact disc holder (36) integrated with an exterior surface of the CPU unit and the compact disc holder adapted to receive a compact disc. Claim 32 is anticipated by the method of using the unit of Loudenslager. As to claim 36, the compact disc holder of Loudenslager is separate from a CD drive.

3. Claims 1-3, 14, 15, 22, 23, 26, 28, 29, 32, 33 and 36-40 are finally rejected under 35 U.S.C. 102(e) as being anticipated by Cloran et al. (5,950,822; hereinafter Cloran'822). Cloran'822 discloses a mountable device/compact disc holder (10) for the display and storage of a compact disc comprising a central opening retainer (20) having a plurality of resilient tabs (21) for securing the compact disc. Cloran'822 further discloses “the device 10 can be attached to a multitude of surfaces, either indoors or outdoors, such as computer hardware, stereos, televisions, monitors, posters, walls car dashboards, entertainment centers, printers, furniture,

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etc.” (column 4, lines 58-62) and “allowed the user to store and access discs conveniently in their work area, on their equipment (such as a stereo or computer hardware) (column 1, lines 49-51).

When the compact disc holder (10) attached to the surfaces as indicated above is considered equivalent to a compact disc holder integrated or unitarily-formed with an exterior surface of a portable electronic device as claimed. Claims 32 and 33 are anticipated by the method of using the device of Cloran'822. As to claims 36-40, the compact disc holder of Cloran'822 is separate from a CD drive.

From WEBSTER'S II NEW RIVERSIDE UNIVERSITY DICTIONARY:

Integrate defines as to make into a whole by bringing all parts together: unify.

Unitary defines as of or pertaining to a unite or units and having the character of a unit: whole.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1-3, 13-15, 22, 23, 26-29, 32, 33 and 36-40 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Cloran et al. (5,950,822; hereinafter Cloran'822) in view of Wolff (5,933,772). Cloran'822 discloses the mountable device/compact disc holder (10) for the display and storage of a compact disc as above having all the limitations of the claims. To the extent that Cloran'822 fails to show a portable electronic device, Wolff teaches a portable electronic device (P) such as pager or other portable item (column 1, lines 45-46) integrated with a coin holder (10) to provide more convenience for a user. The coin holder may be formed integrally with the housing of the pager or other portable item. It would have been obvious to one having ordinary skill in the art at the time the invention was made in view of Wolff to modify the holder of Cloran'822 so the holder is used for attaching to a portable electronic device to provide more convenience for the user.

As to claims 13 and 27, Cloran'822 discloses the compact disc holder can be attached to various electronic devices as above. However, Cloran'822 fails to disclose the device comprises a portable flatbed scanner. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Cloran'822 so the device comprises a portable flatbed scanner to allow the compact disc holder to attach to various devices.

Claims 32 and 33 are drawn to the obvious method of using the holder of Cloran'822 as modified.

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7. Claims 1-3, 13-15, 22, 23, 26-29, 32, 33 and 36-40 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Cloran et al. (5,950,822; hereinafter Cloran'822) in view of Loudenslager (5,828,545). Cloran'822 discloses the mountable device/compact disc holder (10) for the display and storage of a compact disc as above having all the limitations of the claims. To the extent that Cloran'822 fails to show a portable electronic device, Loudenslager teaches a CPU unit/portable electronic device (12) comprising a compact disc holder (36) integrated with an exterior surface of the CPU unit and the compact disc holder adapted to receive a compact disc. It would have been obvious to one having ordinary skill in the art at the time the invention was made in view of Loudenslager to modify the holder of Cloran'822 so the holder is used for attaching to a portable electronic device to provide more convenience for the user. As to claims 13 and 27, Cloran'822 discloses the compact disc holder can be attached to various electronic devices as above. However, Cloran'822 fails to disclose the device comprises a portable flatbed scanner. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Cloran'822 so the device comprises a portable flatbed scanner to allow the compact disc holder to attach to various devices. Claims 32 and 33 are drawn to the obvious method of using the holder of Cloran'822 as modified.

8. Claims 4 and 16 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 2 and 15 above, and further in view of Cerda-Vilaplana et al. (5,933,772; hereinafter Cerda-Vilaplana'186) or Sommi (5,570,791). The holder of Cloran'822 further fails to show at least one ridge. Cerda-Vilaplana'186 shows a disc holder comprising a

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central opening retainer (2, 4, 5, 8) for retaining a central opening of a compact disc and at least one ridge (9) for protecting an edge of the compact disc. Sommi suggests a disc holder (10, 12) comprising a central opening retainer (22) for retaining a central opening of a compact disc and at least one ridge (30) for protecting an edge of the compact disc. It would have been obvious to one having ordinary skill in the art in view of Cerda-Vilaplana'186 or Sommi to modify the holder of Cloran'822 as modified so the holder includes at least one ridge for protecting the edge of the compact disc to prevent the edge from being damaged.

Response to Arguments

Applicant's arguments with respect to 10/31/2005 have been considered but are deemed to be moot in view of the new grounds of rejection.

Applicant's arguments with respect to Cloran'822 under U.S.C. 102 rejection are noted. They are not persuasive because when the compact disc holder of Cloran'822 is attached on the surfaces of the electronic devices as indicated above is considered equivalent to a compact disc holder integrated or unitarily-formed with an exterior surface of a portable electronic device as claimed (see the definitions of integrate and unitarily formed above).

Applicant's arguments with respect to Cloran'822 under U.S.C. 103 rejection are noted. They are not persuasive for the same reasons as indicated above.

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luan K. Bui whose telephone number is (571) 272-4552. If in receiving this Office Action, it is apparent to Applicant that certain documents are missing from the record for example copies of form PTO-1449, form PTO-892, etc., requests for copies of such papers should be directed to Ms. Errica Miller at (571) 272-4370. **Facsimile correspondence for this application should be sent to (571) 273-8300 for Formal papers and After Final communications.**

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lkb
December 8, 2005



Luan K. Bui
Primary Examiner